

Application No. 09/976,679

Reply to Office action of December 30, 2003

REMARKS/ARGUMENTS

In response to the Office Action mailed December 30, 2003, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

By this Amendment, Applicants have amended claim 1 and have added new claims 27-31. Still further, Applicants have amended the specification to update the status of the referenced patents and patent applications. No new matter is added by this Amendment. All of the Examiner's grounds for rejection have now been addressed and Applicants therefore respectfully request that the Examiner pass the pending claims to allowance.

Rejection of claims 1, 2, 7, 8, 17-19 and 21-23 under 35 U.S.C. § 102(e)

The Examiner rejected claims 1, 2, 7, 8, 17-19 and 21-23 as being anticipated by Palmer et al. Regarding claim 1, the Examiner asserts that Palmer et al. disclose a medical device, comprising: an elongate tubular body having a proximal end and a distal end and a lumen extending therethrough (tubular member 102); an inner wire within the lumen of the elongate tubular body having a proximal end extending proximal to the proximal end of the elongate tubular body and a distal end (needle 16, shaft 16), the inner wire being movable relative to the elongate tubular body (FIGS. 3-5); an expandable member connected to the distal end of the elongate tubular body (basket 116); and a coil extending over the inner wire at a proximal end thereof (coil 14), the coil being attached to the proximal end of the elongate tubular body (Column 7 line 58-Column 8 line 25).

Regarding claims 2 and 17, the Examiner asserts that Palmer et al. disclose a proximal hypotube (tube 12) connected to a proximal end of the coil, wherein the inner wire extends through the proximal hypotube.

Regarding claim 8, the Examiner asserts that Palmer et al. disclose that the coil is compressed when the occlusive device is in a non-expanded configuration (Column 5 line 63-Column 6 line 11).

Regarding claim 19, according to the Examiner, Palmer et al. disclose that when the occlusive device is in its expanded configuration, a gap is defined between the tubular body and the proximal hypotube (FIG. 4).

Finally, regarding claim 21, the Examiner asserts that Palmer et al. disclose a coil (coil 14) between the proximal hypotube and the tubular body.

With respect to independent claim 1, the Examiner asserts that Palmer et al. disclose a coil being attached to the proximal end of the elongate tubular body. In particular, the Examiner points to Column 7, line 58 through Column 8, line 25 of Palmer et al., which provides the detailed description of Figure 11. Figure 11 of Palmer et al. illustrates an embodiment wherein an end 522 of the coil is attached to a shaft 516, e.g., by a weld 552. The coil has an outer diameter that interferes with the inner surface 518 of the tube 512. However, the coil is not attached to the tube. Accordingly, Palmer et al. fail to disclose a coil being attached to the proximal end of the elongate tubular body, as recited by Applicants.

Although Applicants do not agree with the Examiner's rejection of claim 1 based on Palmer et al., Applicants have amended independent claim 1 to further clarify the claimed invention over Palmer et al. Claim 1 now recites that the coil is fixedly attached to the proximal end of the tubular body. As discussed above, Palmer et al. merely teach a coil that interferes with a tube and fail to teach or suggest a coil having a distal end fixedly attached to the proximal end of an elongate tubular body.

With respect to independent claim 17, the Examiner asserts that Palmer et al. disclose a proximal hypotube (tube 12) connected to a proximal end of the coil, wherein the inner wire extends through the proximal hypotube. However, Applicants' independent claim 17 recites a proximal hypotube 104 attached to the proximal end of the inner wire 24. Palmer et al. fail to disclose or suggest a proximal hypotube attached to the proximal end of an inner wire. In fact, the purpose of the device disclosed by Palmer et al. is to provide an assembly 10 having a tube 12 that is longitudinally movable relative to the shaft 16 (i.e., inner wire).

In summary, Palmer et al. fail to teach or suggest the unique combination of features recited by Applicants' independent claims 1 and 17. Furthermore, Palmer et al. fail to teach or

Application No. 09/976,679

Reply to Office action of December 30, 2003

suggest the unique combination of features of the claims that depend on claims 1 and 17. Therefore, Applicants respectfully request that the Examiner withdraw the rejections of claims 1, 2, 7, 8, 17-19 and 21-23 under 35 U.S.C. § 102(e) based on Palmer et al.

Rejection of claims 9 and 24 under 35 U.S.C. § 103(a)

The Examiner rejects claims 9 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Palmer in view of U.S. Patent No. 4,878,898 to Griffin et al. The Examiner concedes that Palmer does not disclose an expandable member being a balloon. However, the Examiner asserts that Griffin et al. disclose a balloon catheter provided with a marking to indicate the penetration depth of the instrument. The Examiner then asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the marker device of Palmer with the balloon of Griffin since it is known in the art to provide balloon catheters with depth markers.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). For the reasons discussed above, Palmer et al. fail to teach or suggest each of the claim limitations recited in Applicants' independent claims 1 and 17. Accordingly, the cited combination of Palmer et al. and Griffin et al. fails to teach or suggest each of the claim limitations recited in dependent claims 9 and 24. Therefore, Applicants respectfully request that the Examiner withdraw the rejections of claims 9 and 24 under 35 U.S.C. § 103(a).

Allowable Subject Matter

Applicants appreciate the Examiner's determination that claim 4 is allowable over the cited art. If necessary, claim 4 will be rewritten as an independent claim including all the limitations of the base claim (claim 1) and the intervening claim (claim 2).

Application No. 09/976,679

Reply to Office action of December 30, 2003


CONCLUSION

In light of the foregoing amendments to the claims and the above remarks, Applicants believe this application is in condition for allowance, and such action is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the attorney of record at the telephone number indicated below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 29, 2004

By: 

David L. Hauser

Registration No. 42,643

Attorney of Record

2040 Main Street

Fourteenth Floor

Irvine, California 92614

(949) 721-7624